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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,399	06/12/2001	Travis J. Parry	10011064-1	7135

7590 12/16/2004

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

SON, LINH L D

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/880,399	Applicant(s) PARRY ET AL.	
	Examiner Linh Son	Art Unit 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>06/12/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 6-8, 10-12, and 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Dietl et al, US Publication 20020063760A1, hereinafter '760.
3. As per claims 1 and 10, "a method for self-authenticating a marking agent cartridge, wherein said method is comprised of the steps of: installing an identification means on a marking agent cartridge" is taught in '760 (Para 0015); "installing said cartridge in a printer; automatically reading said identification means on said cartridge by said printer; determining if said cartridge is a counterfeit; and accepting/rejecting said cartridge" is taught in '760 (Para 0017-0020).
4. As per claims 2 and 11, "the method, as in claims 1 and 10, wherein said marking agent is further comprised of: toner" is taught in '760 (Para 0017).

5. As per claims 3 and 12, "the method, as in claims 1 and 10, wherein said marking agent is further comprised of: ink" is taught in '760 (Para 0017).

6. As per claims 6 and 15, "the method, as in claims 1 and 10, wherein said step of installing an identification means on said marking agent is further comprised of the steps of: forwarding first information regarding said identification means to a database; and compiling said first information in said database" is taught in '760 (Para 0019).

7. As per claims 7 and 16, "the method, as in claims 6 and 15, wherein said determining step is further comprised of the steps of: automatically reading said identification means on said cartridge by said printer in order to obtain second information regarding said identification means; and comparing said first information of said identification means with said second information of said identification means" is taught in '760 (Para 0017-0019).

8. As per claims 8 and 17, "the method, as in claims 7 and 16, wherein said accepting/rejecting step is further comprised of the steps of: accepting said marking agent cartridge as being genuine if said first information of said identification means substantially matches said second information of said identification means; and rejecting said marking agent cartridge as being counterfeit if said first information of said identification means does not substantially match said second information of said

identification means" is taught in '760 (Para 0017-0020).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 4-5, 9, 13-14, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over '760 in view of Hagstrom et al, US Patent No. 6354502B1, hereinafter '502.

11. As per claims 4-5 and 13-14, "the method, as in claims 1 and 10" is taught in '760. However, "the said identification means is further comprised of: a bar code" is not taught in '760. Instead, an identification chip is implemented to authenticate the cartridge. Nevertheless, the bar code label is implemented in '502 to identify the authenticity of the ink cartridge (Fig. 9, 10, 11, Col 1 line 39, Col 1 lines 35-55 and Col 9 lines 63-65). Therefore, it would have been obvious at the time of the invention for one having ordinary skill in the art to also implement bar code identification means instead of computer chip to store identification data. Further, the bar code would be cheaper to implement than the computer chip.

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12. As per claims 9 and 18, "the method, as in claims 1 and 10" is taught in '760. Further, the method also includes steps of notify the user if the marking agent cartridge is not confirmed or authentic. However, "the said method is further comprised of the step of: notifying a producer/supplier of said marking agent cartridge if said marking agent cartridge is rejected as being counterfeit" is not taught in '760. Nevertheless, it would have been obvious at the time of the invention was made for one having ordinary skill in the art that a message can also be send to the supplier since the internet is readily available to most home or office computers (Col 4 lines 40-43).

Conclusion

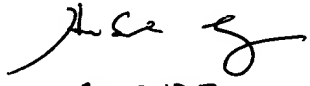
13. Any inquiry concerning this communication from the examiner should be directed to Linh Son whose telephone number is (571)-271-3856.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Kim Y. Vu can be reached at (571)-272-3859. The fax numbers for this group are (703)-872-9306 (official fax). Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (571)-272-2100.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval IPAIR.I system. Status information for

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published applications may be obtained from either Private PMR or Public PMR. Status information for unpublished applications is available through Private PMR only. For more information about the PAIR system, see <http://pzd-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


AU 2135

Linh LD Son

Patent Examiner